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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/578,629	05/09/2006	Kanichi Sato	23697-003US1 / NF-2995	1402

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EXAMINER
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GUTMAN, HILARY L

ART UNIT	PAPER NUMBER
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3612

NOTIFICATION DATE	DELIVERY MODE
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11/12/2008

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

PATDOCTC@fr.com

<b>Office Action Summary</b>	<b>Application No.</b> 10/578,629	<b>Applicant(s)</b> SATO, KANICHI	
	<b>Examiner</b> Hilary Gutman	<b>Art Unit</b> 3612	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 30 October 2008 and 02 September 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1,3-8 and 11-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3-8 and 11-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                       | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>10/30/08</u> .  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Claim Objections***

1. Claims 14 and 19 are objected to because of the following informalities:

In claim 14, on line 2 a period should be inserted at the end of the claim.

In claim 19, on lines 1-3, the phrase "the noise absorption layer...such that" is repetitive and redundant. It should be deleted altogether since it was previously recited in claim 1.

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1, 4-7, 12-13, 16-19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 contains the negative limitation "not entirely occupied". The negative limitation does not claim what the invention is, merely what it is not (See MPEP 2173.05(i)).

Claim 12 recites the limitation "a part of the surface *or* an entire surface of the rib." The alternative structure renders the claim indefinite as it is unclear what exactly is being claimed.

With regard to claims 16-18, line 3, the phrase "using which" is awkward and unclear as to what the applicant intends to recite. Modification or explanation should be made.

### ***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1, 3, 8, 19-20 are rejected under 35 U.S.C. 102(b) as being clearly recited by Hatayama et al. (5,690,035).

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1, 3-8, 11-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tokunaga et al. (JP '544) in view of Furukawa et al. (JP '146) and Hatayama et al. (5,690,035).

JP '544 discloses the claimed invention (Figure 4) including an interior material, which is a panel forming body of a vehicle comprising at least a structure member 11 and a noise absorption layer 14, wherein the structure member has at least one rib 12 which is formed on the inside surface of a base portion thereof and comes into intimate contact with an inside surface of an exterior material 13, a hermetically sealed hollow portion is formed by the rib in intimate contact with the exterior material; and the inside surface of the structure member and a part of the surface of the rib are provided with the noise absorption layer. JP '544 also discloses the inside surface of the structure member confronting the exterior material.

JP '544 lacks the noise absorption layer disposed on the outside surface of the structure member and maintaining the hollow portion.

Furukawa et al. teaches (Figure 1) an interior material of a vehicle comprising a noise absorption layer 2 disposed on an outside surface of the structure member 1.

Hatayama et al. teach a structure member comprising ribs 4 wherein a noise absorbing material 10 is disposed on the rib while maintaining hollow portions 8.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the device of JP '544 with a noise absorption layer on the exterior surface, as taught by JP '146, and with hollow portions, as taught by Hatayama et al., in order to provide extra dampening to the material and selected acoustic properties.

With regard to claims 4 and 5, JP '146 (paragraph 0016) teaches the structure member 1 being made of an ABS resin and the noise absorption layer being made of foaming urethane of PE resin.

With respect to claim 6, JP '146 teaches (paragraph 0027) a surface clad material 3 is attached to a surface of the noise absorption layer opposite the structure member side.

With regard to claim 7, it is well known in the art to treat surface materials with dirt prevention solutions, such as 'Scotchguard', and therefore would have been obvious to one of ordinary skill in the art at the time the invention was made to do so.

For claims 16-18, it is further well known in the art to drill or otherwise form holes in vehicle body panels to allow features to be attached thereto or to allow electrical wires or other controls to pass therethrough and therefore would have been obvious to one of ordinary skill in the art at the time the invention was made to do so.

***Response to Arguments***

8. Applicant's arguments filed 9/2/08 have been fully considered but they are not persuasive.

With regard to the 112 second paragraph rejection, the applicant made no changes to previously rejected claim 12 which still states "a part of the surface or an entire surface".

Therefore the rejection is hereby maintained. With regard to the negative limitation, the applicant has apparently exchanged one negative limitation for another. Therefore, a new rejection with regard to claim 1 is set forth above.

With regard to the 103 rejections, the applicants changes have broadened the claim scope stating now that only at least one of the three surfaces: outside surface of the structure member, inside surface of the structure member, and surface of the rib need be covered with a noise absorption layer. Due to this broadening of the claim, a 102(b) rejection has been set forth.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, both Hatayama and Tokunaga deal with the vibration dampening and looking toward the sound insulation properties of the Hatayama reference, one could optimize the acoustics and characteristics of Tokunaga and provide extra noise dampening to the material.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., the noise insulation layer being definitively disposed on a part of the surface of the rib) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hilary Gutman whose telephone number is 571-272-6662.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenn Dayoan can be reached on 571-272-6659. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Hilary Gutman/  
Primary Examiner, Art Unit 3612